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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/516,865 | 08/05/2005 | Derek M. Blaha | 2838PCTUS(203-3033 PCTUS) | 8547 |
| 7590 | 11/02/2006 | | EXAMINER FRIEDHOFFER, MICHAEL A | |
| Mark Farber United States Surgical a Division of Tyco Healthcare Group 150 Glover Avenue Norwalk, CT 06856 | | | ART UNIT 2832 | PAPER NUMBER |

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,865

Applicant(s)

BLAHA ET AL.

Examiner

Michael A. Friedhofer

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/29/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 11-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, lines 4-5 "said pedal" should be --said at least one pedal--.

In claim 11, line 5 replace "the function" with --a function--.

In claim 11, line 5 replace "the pedal" with --the at least one pedal--.

In claim 11, line 6 replace "said pedal" with --said at least one pedal--.

In claim 25, line 1 replace "20" with --23--.

In claim 28, line 6 replace "the function" with --a function--.

In claim 28, lines 6-7 replace "each foot-activatable pedal" with --each of the foot-activatable pedals--.

In claim 28, line 11 replace "said pedal" with --each of said pedals--.

In claim 29, line 5 "each foot-activatable pedal" has no antecedent basis.

In claim 29, line 6 replace "the function" with --a function--.

In claim 29, line 6 "each foot-activatable pedal" has no antecedent basis.

In claim 29, line 8, both instances, "each foot pad" with --each of the foot pads--.

In claim 29, line 9 replace "said pedal" with --said at least one pedal--.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2832

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 20, 21, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Telymonde et al.

Telymonde et al discloses in figures 1-6 a control system for an electrosurgical instrument including a housing 12 selectively positionable relative to an operating theater and coupled to an electrosurgical energy source; at least one foot activatable pedal 14 operatively engaged with the housing and including indicia 56; and means 58 for illuminating at least a portion of the pedal to illuminate the indicia. The indicia is formed in an upper surface of the foot pedal with the indicia being illuminated from within the pedal. Foot pad 67 is disposed on the upper surface of the pedal. As for the indicia being formed by a groove having transparent or translucent material, this is a matter of engineering design choice not affecting the structure or operation of the switch in which any well known method of illumination may be utilized to perform the same function.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Telymonde et al in view of Chappuis.

Telymonde et al discloses all of the claimed limitations with the exception of there being a plurality of pedals.

Chappuis teaches that in a control system for electrosurgical instruments a plurality of similar foot switches may be utilized in a common base for operating a plurality of instruments.

It would have been obvious to one of ordinary skill in the art to apply the teachings of Chappuis to Telymonde et al to provide a plurality of foot switches for operating the control system because this is for the purpose of reducing the number of locations required for operating the instrumentation making it more conducive for surgical operations. As for the means for illumination blinking or for the illumination means of each pedal being a different color from one another, these are a matter of engineering design choice in which a large plurality of methods of illumination are well known for the purpose of differentiating between the switches for ease of operation and reduction in misoperation.

Allowable Subject Matter


6. Claim 28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
7. Claims 16-19 and 23-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lieb, Didato, Lai, and Anderson et al teach various foot operated switches that may or may not be illuminated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Friedhofer whose telephone number is 571-272-1992. The examiner can normally be reached on Mon-Fri 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael A. Friedhofer
Primary Examiner
Art Unit 2832

maf